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No. 73-1480

In the
Supreme Court of the United States
OCTOBER TERM, 1973

DONALD M. UMPHREY and
DOUGLAS J. MARSDEN,
Petitioners,

vs.

McGRAW-EDISON COMPANY,
Respondent.

PETITION OF UMPHREY ET AL. FOR RECONSIDERATION OF COURT ORDER OF MAY 28, 1974 DENYING PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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This is a request by the above-named Petitioners for Reconsideration of the Order of this Court, dated May 28th, 1974, in the subject action.

Petitioners firmly believe that the grounds and questions presented to the Court by their initial Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit are each of a form of universal and national interest, not only to said Petitioners but also to the entire manufacturing and development

industry, as well as to large groups of inventors in this country. The issues were not in any respect restricted only to the Petitioners.

From the standpoint of this Court it is respectfully represented that the issues are strictly legal and a review and reconsideration would not involve the Court in difficult technical propositions. The subject matter of the Umphrey patent involved (Patent No. 2,909,633—hereinafter called '633) has been declared novel by each of the District Court and the Court of Appeals.

The presented questions for this Court to answer are all of genuine merit, as well as being of substantial national and universal significance.

Petitioners cannot help but believe that Your Honors failed to realize fully the scope of this case. The original Petition sets forth plainly that the Court of Appeals failed completely to follow the provisions of Rule 52(a) of the Fed. R. Civ. P. (and thus the law of this Court) or it could not have rightly denied Petitioners' right to an affirmance of the decision of the District Court. The District Court, with the benefits of trial testimony, had full opportunity to observe and appraise the full extent, depth and substance of the testimony of each of the witnesses in court. This included Respondent's expert. After having had the benefit of hearing all of the witnesses directly, as well as to have had the advantage and opportunity to read the depositions taken by each of the parties to the action, the District Court had full benefit and depth of understanding of the witnesses' testimony and had a complete, pertinent rule of calibration that enabled it to establish the true and complete relationship between the patent as to its structure and

function and the corresponding structure and function of the accused device. It then stated:

> "The accused circuit breakers and the circuit breakers described and claimed in the '633 patent are *organizationally and functionally identical. . . .*" (all emphasis in this and other quotations and decisions herein supplied unless otherwise noted; full decision appears at pages B6 to B15 of original petition).

Even the Court of Appeals stated that the Umphrey concept in the '633 patent is present in Respondent's device (see full Court of Appeals decision in Appendix of Petition and particularly note Appendix at page B21 starting at line 6 from the bottom of the page). But, while so admitting, the Court of Appeals failed to apply the rule of law that if a combination is new and novel the addition of an unpatented component thereto, which does not basically change the operation, must fall fully within the generic concept. Any patent claims generic to the combination still cover and dominate both structures even though there is an unpatentable addition to the basic claim. This view follows precisely that expressed in this Court's decision in *Temco Electric Motor Co.* v. *Apco Mfg. Co.*, 275 U.S. 319 (1928).

The Court unequivocally stated this well established rule in the *Temco* case (supra) where it made clear the fact that "—an improver without a license is an infringer and may be sued as such." Failure of the Supreme Court to refute at this time the Court of Appeals' view to the effect that the addition of an unpatented component to a structure organizationally and functionally identical to that of the Petitioner's patent, and a holding that this makes a new combination, deprives the Petitioner Umphrey of his constitutional right. Any adherence

to the Court of Appeals' view stands, in effect, as a full rejection of the noted heretofore landmark decisions. It should not be overlooked that this Court cited much prior support for the rule of the *Temco* case, supra, and its interpretation. Consequently, failure to refute in all respects the Court of Appeals presents a chaotic situation in the patent law which should not exist. Furthermore, such refusal to hear Petitioners acts to encourage piracy of inventions, as seems to be the case here.

To show and prove the identity of the teachings and the invention of Petitioner Umphrey as expressed in the '633 patent with the structure of the Respondent this Court is again respectfully urged to note very carefully that even the Respondent recognized the identity in the preparation of its descriptive promotion material (see original Petition, pages 7 and 8). By this material it cannot help being self-evident that Respondent *copied exactly* four very significant paragraphs from the '633 patent.

Not only did the Court of Appeals fail to follow Rule 52(a) of the Fed. R. Civ. P. and the many rulings previously made by this Court but it wrongly *substituted* its own *Assumptions* for the Fact Findings of the District Court—contrary, of course, to this Court's ruling in the case of *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966).

It is utterly inconceivable that the Court of Appeals could admit the novelty in Petitioner's patent and then utterly ignore the rule of law so consistently and continuously set forth by this Court for almost a century (see, for instance, the numerous cases cited in respect of Question 3 of the original Petition at its page 3). Such holdings by a Court of Appeals and the denial of

the original Petition by this Court eliminate any chance to follow the long established rule of law that it is the *claims* of a patent which determine its scope—not the appellate *assumptions* which cannot be reconciled with the views of the trial experts or those of the District Court. This point is made in the original Petition at its pages 23 and 24, and is supported by *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 274-275 (1949), *Ramirez* v. *Perez*, 440 F.2d 1072 (5 Cir. 1971), *Cochrane* v. *Deener*, 94 U.S. 780 (1876), and many similar cases.

The day of the individual inventor would disappear if the findings of a trial court are set aside by subsequent conjectural findings where such conjectural findings are not supported by any testimony on which the trial court's findings are based. As a result, this case really takes away several significant foundation stones from the patent law and the basic prohibitive provisions of Rule 52(a), Fed. R. Civ. P. The gist of the District Court's findings was that this modest inventor had made a significant invention which stands infringed by a behemouth corporation with endless power and financial resources. Nonetheless, the Court of Appeals has completely disregarded these prior decisions of this Court which have heretofore been regarded as pillars of the patent system, as above noted.

Such a situation would permit no justice whatsoever. Where a District Court has so strongly ruled for Petitioners and the Court of Appeals disregards the significant basic fact findings in applying this invention to the infringing structure, the appellate decision cannot be equitable.

This Court is the only place where this ambiguous inconsistency has an opportunity to be reviewed and clarified. This is why Petitioners are here.

Your Petitioners hereby most respectfully seek, urge and request a full reconsideration of the Petition.

Respectfully submitted,

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